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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICARDO ALEXANDER GOMEZ

Appeal 2008-005828
Application 10/826,869
Technology Center 3700

Decided:¹ July 22, 2009

Before DONALD E. ADAMS, DEMETRA J. MILLS, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

The following claim is representative.

1. A sterile apparatus to protect endoscope(s) comprising:
an impact resistant housing having an outer surface defining an opening,
an interior of the housing defining a canal having a first end communicating with the opening and a second end terminating within the housing for receiving a distal lens of an endoscope;
a defogging material disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal; and
a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal.

Cited References

Dohm et al.	US 5,720,391	Feb 24, 1998
Beane et al.	US 2002/0022762 A1	Feb. 21, 2002
Lantz	US 6,910,582 B2	Jun. 28, 2005

Grounds of Rejection

1. Claims 1-7, 10-15 and 42 are rejected under 35 U.S.C. § 102(b) over Beane.
2. Claim 8 is rejected under 35 U.S.C. § 103(a) over Beane in view of Dohm.
3. Claim 9 is rejected under 35 U.S.C. § 103(a) over Beane in view of Lantz.

ISSUE

The Examiner argues that Beane discloses an endoscope having each of the claimed elements.

Appellant contends that Beane “does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal.” (App. Br. 5.)

The issue is: Has Appellant demonstrated that the Examiner failed to provide evidence in the prior art of a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal.

FINDINGS OF FACT

The Examiner finds that:

1.

Beane . . . disclose[s] a sterile apparatus to protect endoscopes comprising: an impact resistant housing 110 having an outer surface defining an opening, an interior of the housing defining a canal having a first end communicating with the opening and a second end terminating within the housing for receiving a distal lens of an endoscope (see Figs. 2a-f); a defogging material disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal (see paragraph 0056); and a self-sealing mechanism 128 disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal (see paragraph 0053).

(Ans. 4.)

2. Beane, Fig. 2A is reproduced below.

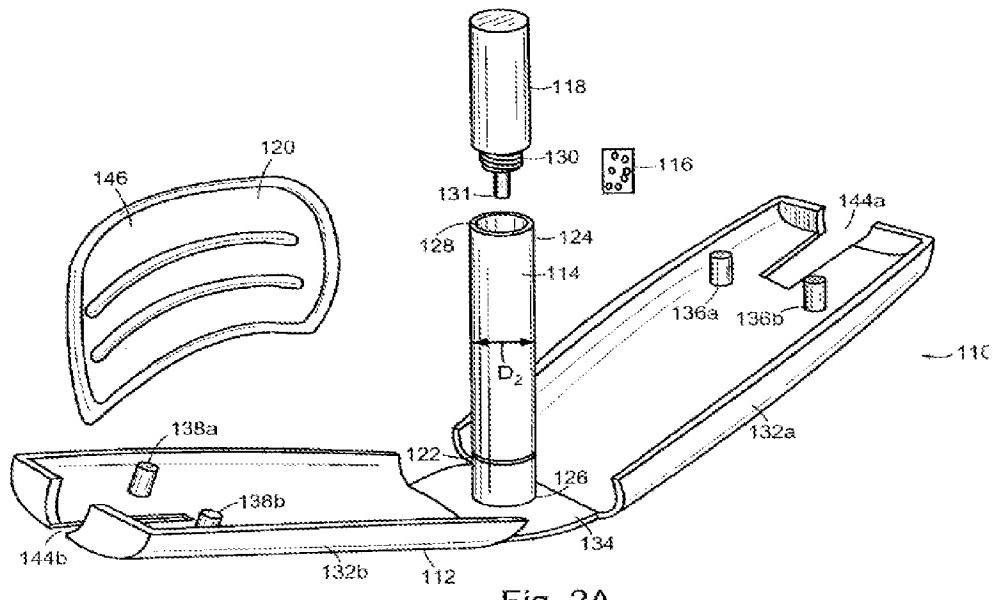


Fig. 2A

Beane, Fig. 2A shows an apparatus for cleaning a surgical instrument such as an endoscope wherein a defogging solution 118 is added to a canal at a distal end, and a laparoscope is inserted through a hole 140 in base 134. A sponge is disposed snugly within tube 114, near distal end 124.

Alternatively bottle 118 and distal end 124 can be attached by an interference or press fit using an O-ring. (Beane 3: ¶ 0053-0055.)

3. Beane discloses “a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is Styrofoam.” (Ans. 6.)

4. “Dohm . . . teach[es] a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a styrofoam material (see col. 5, lines 64-66). Dohm . . . thus demonstrate that the use of stryrofoam materials for cushioning a medical device during transport are well known in the art.” (Ans. 6.)

5. The Examiner finds that “[I]t would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize Styrofoam in the apparatus of Beane . . . as an alternate means for cushioning the endoscope.” (Ans. 6.)
6. “Beane . . . disclose[s] a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is a gel.” (Ans. 6-7.)
7. “Lantz teaches a similar transportation case having a gel pack 40 for cushioning. (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art.” (Ans. 7.)
8. The Examiner finds that “[I]t would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a gel in the apparatus of Beane . . . as an alternate means for cushioning the endoscope.” (Ans. 7.)
8. The Specification, page 8, discloses that inside the canal, between the reservoir filled with defogging solution and the central sheath, is a valve mechanism. The valve, such as that resembling a human vein provides a self-sealing mechanism to prevent leakage and backsplash of fluid. (Spec. 9.)

Principles of Law

In order for a prior art reference to anticipate a claimed invention, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

Analysis

Appellant contends that “Beane . . . does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal.” (App. Br. 5.)

Appellant argues that the Beane “interference or press fit referred to by the Examiner merely has to do with how the walls of the bottle 118 and the tube 114 are attached to one another at a distal end 124 of the tube 114, and how the walls of the tube 114 and the housing 112 are attached at a proximal end 122 of the tube 114.” (App. Br. 6.) In Beane,

The interference or press fit has nothing to do with teaching a mechanism disposed within the tube 114 which would self-seal so as to obstruct and prevent fluid from spilling out of the tube. . . . The solution of Beane . . . is retained in a sponge. The present application lists examples of self-sealing mechanisms as, for example, a tube within a tube mechanism, valves including those resembling a heart valve or a valve in a human vein, a flap and hinge valve which opens only in one direction, and a ball and socket mechanism. (See page 8, line 21 to page 9, line 9).

(App. Br. 6.)

Appellant argues that

An O-ring as taught by Beane . . . would be configured and implemented to hold together the walls of the bottle 118 and the tube 114, and possibly to prevent fluid from leaking through the walls of the bottle and tube where the ends of the walls are connected to one another. This O-ring is not configured or implemented to prevent fluid from escaping from the canal (i.e., through the canal opening).

(App. Br. 6.)

In sum, Appellant argues that, because Beane “does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal” Beane does not anticipate the pending claims. (App. Br. 6-7.)

We agree with Appellant that the Examiner has failed to provide sufficient evidence in the prior art of a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal.

Claims 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Dohm.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane in view of Lantz (U.S. Patent No. 6,910,582).

We do not find that Dohm or Lantz overcome the deficiencies of Beane, and the rejections of claims 8 and 9 are reversed.

Conclusion of Law

Appellant has demonstrated that the Examiner failed to provide evidence in the prior art of a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material

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and to prevent the defogging material from spilling out of the canal. The anticipation and obviousness rejections are reversed.

REVERSED

cdc

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